

REMARKS

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks.

Regarding the Moore Reference (US 2001/0047298 A1), hereinafter "Moore"

Upon review of the Moore Reference, the undersigned notes that Moore's actual filing date is March 30, 2001. This is later than the January 3, filing date of Applicants' application. Moore claims priority benefit of a provisional application 60/193,948 filed March 31, 2000 (Hereinafter "the provisional"). Thus the provisional does predate Applicant's filing date. However, in this scenario the undersigned submits that Moore is only valid prior art for information contained in the provisional. Any information added when the Moore non-provisional application was filed is not available for use against Applicants' invention.

The undersigned has obtained a copy of the provisional, which is enclosed for the Examiner's ease of reference. It is noted that the provisional contains no figures or drawings whatsoever, and only five pages of text. There is clearly no one-to-one correspondence between the comparatively extensive disclosure of Moore and the comparatively brief (and questionably enabling) disclosure present in the provisional.

Accordingly, where disclosure cited in the rejection of claims or its equivalent does not appear in the provisional, all rejections based upon Moore clearly fail to establish a *prima facie* case of unpatentability.

Regarding the Rejections:**Regarding Independent Claims 1 and 24**

The Office Action explains that the rejections are based upon disclosure in Moore at paragraphs 22, 32, 40, 43, 47, and Fig. 7. The undersigned is unable to readily identify disclosure in the provisional that directly corresponds to much of this disclosure. The

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provisional contains no figures, thus the disclosure of Fig. 7 is not available *per se* for use in this rejection. Paragraph 22 appears to approximately correspond to the paragraph spanning pages 3 and 4 of the provisional. The undersigned finds no disclosure that corresponds at all to paragraphs 32. The undersigned finds no disclosure that directly corresponds to the disclosure of paragraph 43, however, the provisional does appear to show that the advertisement content can be updated as time passes. No basis seems to be given for modifying the advertisements other than for the purpose of updating the advertisements "as time passes" or "at some suitable frequency". There appears to be no disclosure in the provisional that corresponds to the disclosure of paragraph 47, which describes Figure 7.

In view of the above, it is submitted that a *prima facie* case of unpatentability has not been established for independent claims 1 and 24, and thus claims 1-24 in the present Office Action.

That notwithstanding, specifically regarding claim 1, the undersigned has reviewed the provisional in some detail and notes that it might be possible to read independent claim 1 on a scenario as laid out in the provisional in which an advertisement is modified to periodically provide a "fresh" advertisement. The provisional provides no basis for modifying ancillary information on the basis of a number of times the programming is presented or on a randomized basis as called for in amended claim 1. Accordingly, claim 1 has been amended as described to specify that a plurality of segments of ancillary information is provided, and that the ancillary information is selected either 1) on the basis of a number of presentations of the segment of programming or 2) by randomly selecting the ancillary information.

Specifically regarding claim 24, although the provisional provides no suggestion for omission of advertising information, the undersigned feels it appropriate to clarify that the ancillary information is selected from a plurality of segments of ancillary information on the basis of a selection algorithm. Thus, claim 24 has been amended to provide such clarification. It is noted that there is and can be no suggestion of omission of an advertisement on the basis of an algorithm per claim 24 since revenue is derived from showing the advertisement – thus why would one omit presenting the advertisement on the basis of some algorithm. Claim 24 has been

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amended to specify that the selection of ancillary information is on the basis of a selection algorithm which can include omission of presentation of the ancillary information.

These embodiments of amended claims 1 and 24 are clearly supported by the disclosure associated with Figures 7 and 8. This amendment is also consistent with original claims 8 and 9 which are submitted to be allowable in their originally submitted form, and are substantially unchanged in scope by the present amendment. In view of the above, reconsideration and allowance of claims 1-24 are respectfully requested.

Regarding Independent Claim 25

The Office Action explains that the rejections are based upon disclosure in Moore at paragraphs 22, 32, 40, 43, 47, and Fig. 7. As noted above, the undersigned is unable to readily identify disclosure in the provisional that directly corresponds to much of this disclosure. The provisional contains no figures, thus the disclosure of Fig. 7 is not available *per se* for use in this rejection. Paragraph 22 appears to approximately correspond to the paragraph spanning pages 3 and 4 of the provisional. The undersigned finds no disclosure that corresponds at all to paragraphs 32. The undersigned finds no disclosure that directly corresponds to the disclosure of paragraph 43, however, the provisional does appear to show that the advertisement content can be updated as time passes. No basis seems to be present in the provisional for modifying the advertisements other than for the purpose of updating the advertisements "as time passes" or "at some suitable frequency". There appears to be no disclosure in the provisional that corresponds to the disclosure of paragraph 47, which describes Fig. 7.

In view of the above, it is submitted that a *prima facie* case of unpatentability has not been established for independent claim 25. Additionally, it is noted that although there is a disclosure in the provisional in which an advertisement is modified to update the advertisement over time, the undersigned finds no suggestion that such modification involves the static and variable segments called for by this claim. This is asserted to be disclosed in paragraph 43 of the Moore reference. Applicants respectfully disagree that this is taught, suggested or even hinted at. Moreover, to the extent that any similar disclosure exists in the provisional, there is only disclosure of replacement of the advertisement. Such disclosure clearly falls short of that

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required to establish anticipation. Accordingly, claim 25 is submitted allowable as filed. Reconsideration and allowance are respectfully requested.

Regarding Independent Claim 26:

The Office Action explains that the rejections are based upon disclosure in Moore at paragraphs 22, 32, 35, 40, 43, 47, and Figures 2 and 7. As noted above, the undersigned is unable to readily identify disclosure in the provisional that directly corresponds to much of this disclosure. The provisional contains no figures, thus the disclosure of Figures 2 and 7 are not available *per se* for use in this rejection. Paragraph 22 appears to approximately correspond to the paragraph spanning pages 3 and 4 of the provisional. The undersigned finds no disclosure that corresponds at all to paragraphs 32. Paragraph 35 describes Figure 2, which is not present in the provisional. The undersigned finds no disclosure that directly corresponds to the disclosure of paragraph 43, however as previously noted, the provisional does appear to show that the advertisement content can be updated as time passes. No basis seems to be given for modifying the advertisements other than for the purpose of updating the advertisements over time, as previously noted. There appears to be no disclosure in the provisional that corresponds to the disclosure of paragraph 47 which describes Figure 7.

In view of the above, there would appear to be a wholly inadequate disclosure in the provisional to support a rejection of claim 26, which calls for selection of the ancillary information to be carried out in a central processor of a television set top box. That notwithstanding, it is believed appropriate to assure that the mechanism for selection of the ancillary information be called out in this claim. Thus, claim 26, has been amended in a manner somewhat similar to claim 24. Claim 26, and therefore all claims dependent thereupon are thus believed to be in condition for allowance. Reconsideration and allowance of claims 26-36 are respectfully requested.

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Regarding Independent Claim 37:

The above remarks regarding claim 24 is equally applicable. Furthermore, claim 37 calls for the selection algorithm to be carried out in program means running on a processor of a television set top box, which is neither taught nor suggested by the provisional. Accordingly, as amended, claim 37 is believed to be in condition for allowance. Reconsideration is respectfully requested.

Regarding Independent Claim 38:

The above remarks regarding claims 25 and 26 (except for remarks relating to amendment) are equally applicable. Accordingly, original claim 38 is believed to be in condition for allowance. Reconsideration is respectfully requested.

Regarding Independent Claim 39:

The above remarks regarding claim 1 are equally applicable, and claim 39 has been similarly amended. Accordingly, claim 39 is believed to be in condition for allowance. Reconsideration is respectfully requested.

Regarding Independent Claim 40:

The above remarks regarding claim 24 are equally applicable, and similar amendments have been made. Accordingly, claim 40 is believed to be in condition for allowance. Reconsideration is respectfully requested.

Regarding Independent Claim 41:

The above remarks regarding claim 25 are equally applicable. Accordingly, original claim 41 is believed to be in condition for allowance. Reconsideration is respectfully requested.

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Concluding Remarks:

Applicant notes that although amendments have been made, certain of the claims as originally filed clearly distinguish over the Moore reference without amendment, when Moore is considered in light of the provisional's disclosure, and on the basis that Moore can only be considered valid prior art for the teachings of the provisional. The provisional fails to provide an adequate disclosure to anticipate or obviate claim features (paraphrased without intent of limitation) such as use of a selection algorithm; use of randomization, omission or number of presentations as a part of a selection algorithm; or carrying out such actions in a television set top box. Other significant disclosure is similarly missing from the provisional. Accordingly, although Applicant has offered amendments herein, such amendments do not in and of themselves necessitate a new grounds for rejection. Such amendments are believed to clearly place the amended claims in condition for allowance.

The undersigned additionally notes that other distinctions exist between the cited references and the invention as claimed. However, in view of the clear distinctions pointed out above, and the partial failure of Moore to constitute prior art, further discussion is believed to be unnecessary at this time. Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position.

No amendment made herein was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim unless an argument has been made herein that such amendment has been made to distinguish over a particular reference or combination of references.

In view of this communication, all claims are now believed to be in condition for allowance and such is respectfully requested at an early date. If further matters remain to be resolved, the undersigned respectfully requests the courtesy of an interview. The undersigned can be reached at the telephone number below.

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Respectfully submitted,



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